

REMARKS

The above amendment is made in response to the Final Office Action mailed May 20, 2004. Claims 1-33 are pending in the present application and stand rejected. The Examiner's reconsideration is respectfully requested in view of the following remarks.

Claims 1-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buist (U.S. Patent No. 6,408,282) in view of Barr et al (U.S. Patent No. 5,761,442) (hereinafter "Barr"). The rejection is respectfully traversed.

The Examiner's arguments are legally insufficient for at least the following reasons.

Claim 1 claims, *inter alia*, "automatically updating...a database having a plurality of entries...respectively comprising at least one name of the publicly traded stock or publicly traded fund, *a weight for the at least one name, and baseforms of the at least one name.*" Without specifically addressing each and every limitation of the claim, the Examiner cites Fig. 60 (which shows an applet version of the *most viewed stocks* shown in Fig. 57A) and col. 6, lines 25-61 of Buist as teaching or suggesting the recited limitations. It is unclear to Applicants which part of Figure 60 or col. 6, lines 25-61 of Buist teaches or suggests "a weight for the at least one name" and "baseforms of the at least one name," as argued by the Examiner. Without specifically addressing each and every limitation of the claims, Applicants are effectively left to *guess* as to which portions of the references supposedly render obvious the claims. It is respectfully submitted that this would not be the case *but for* a legally deficient rejection to the claims. Thus, a legally sufficient rejection showing citations to the references for each and every limitation of the claims is respectfully requested.

Contradicting the Examiner's previous assertion that Buist *does* teach "a weight for the at least one name," the Examiner also asserts that Buist does not explicitly teach "a weight for the at least one name," as claimed in claim 1. A clarification on the contradiction is respectfully requested. The Examiner cites col. 4, lines 51-57 of Barr as teaching "a weight for the at least one name." As motivation for the combination, the Examiner inexplicably cites: "these weights form the basis of both long and short portfolios." This statement does not provide a motivation for combining Buist and Barr; instead, this is simply the purpose of the weights, as described in Barr. Buist teaches a system for supporting trading of securities over the Internet after normal market hours and without involving an exchange. It is entirely unclear to Applicants how one skilled in the art would combine the system, as taught by Buist, with weights describing the estimated performance potential of a stock, as taught by Barr. It is respectfully submitted that any motivation for combining the teachings of Buist with the teachings of Barr, as suggested by the Examiner, can result from only improper hindsight reasoning.

In rejecting the step of "automatically updating...a database," the Examiner "*categorically state[s]* that an automatic means to replace a manual activity is not sufficient to distinguish over the prior art as shown in the case of *In re Venner*." In *In re Venner*, 262 F.2d 91, 94, 120 USPQ 192, 194 (CCPA 1958), the appellants argued that "the basis for allowance of the appealed claims [to an apparatus for molding trunk pistons of aluminum and magnesium alloys] resides in the combination of the old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court stated that "it is well settled that it is not 'invention' to broadly provide a

mechanical or automatic means to replace manual activity which has *accomplished the same result.*” *Venner*, 262 F.2d at 95, 120 USPQ at 194. In *Venner*, however, all limitations in the claims, including the automatic means, *were disclosed in the applied references.* See *Venner*, 262 F.2d at 96, 120 USPQ at 195.

In the present case, unlike in *Venner*, the Examiner has not provided a reference which discloses “*automatically updating...a database having a plurality of entries...respectively comprising at least one name of the publicly traded stock or publicly traded fund, a weight for the at least one name, and baseforms of the at least one name.*” The Examiner has merely relied on a *per se* rule that providing a mechanical or automatic means to replace manual activity which has accomplished the same result is unpatentable. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 27 USPQ2d 1127, 1133 (Fed. Cir. 1995), “reliance on *per se* rules of obviousness is *legally incorrect and must cease.*” Thus, *In re Ochiai* expressly repudiates and discourages the “categorical” assertion made by the Examiner. Moreover, the Examiner has not established that providing real-time updates of buy and sell orders for securities, as taught by the Buist, *accomplishes the same result* as “*automatically updating...a database having a plurality of entries...respectively comprising at least one name of the publicly traded stock or publicly traded fund, a weight for the at least one name, and baseforms of the at least one name,*” as claimed in claim 1. Thus, the Examiner has not legally established proper reliance of *In re Venner*.

Claim 1 further claims, *inter alia*, “automatically updating a grammar file for names in the database, the grammar file including the names and weights for the names.” The Examiner argues that “grammar file,” as claimed in claim 1, is taught or suggested by

“order book,” as disclosed in Buist. As the Examiner correctly states, “claims are interpreted in light of the specification.” (Paper No. 6, p. 3). Under this premise, the term “grammar file” should be interpreted in light of the specification, which relates to a *speech recognition system*. This is further supported by the preamble, which states: “A method for automatically updating stock and mutual fund *grammars* in a *speech recognition system*.” It is respectfully submitted that a “grammar file,” as interpreted by one skilled in the art, is not taught or suggested by Buist, which is *entirely* unrelated to speech recognition systems. Col. 6, lines 36-42 of Buist state that an “order book” contains “real-time data reflecting buy and sell orders for the supported securities” for a user. This is clearly illustrated in Figure 6, which does not show a “grammar file” that can be used in a speech recognition system.

The Examiner “points out that...the Applicant is attacking each reference individually,” citing *In re Keller* and *In re Merck & Co*. The Examiner particularly addresses the Applicants’ argument that Buist is entirely unrelated with speech recognition. Applicants submit that such an argument *is* relevant because it addresses the legal requirement that the Examiner view the invention *as a whole*. This is clearly applicable in refuting a § 103 rejection. Even from a cursory view of the references, it is *very* clear that the combination of Buist and Barr is completely unrelated to the claimed invention *as a whole*.

The Federal Circuit indicated in *In re Fritch*, 972 F.2d 1260, 1266 n.15, 23 USPQ2d 1780, 1783-84 n.15 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or “template” to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. That court has

also cautioned against focusing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), *cert. denied*, 480 USPQ 947 (1987).

In the present invention, the Examiner attempts to piece together a broad statement in the background of Barr (col. 2, lines 41-67: “In the past several years, neural networks...have become popular in solving a variety of problems ranging from protein secondary structure prediction to speech recognition”) with the invention disclosed in Buist. It is respectfully submitted that the Examiner has not viewed the claimed invention as a whole and has improperly focused upon the supposed obviousness of the differences between the claimed invention and the prior art cited against the claims. In particular, the Examiner has attempted to combine a broad statement in the background of Barr into the computer-aided securities trading system disclosed in Buist. Barr simply states that neural networks can be used in solving problems in speech recognition. Buist on its own is entirely unrelated to speech recognition. It is entirely unclear to Applicants how such a broad statement on the use of neural networks in Barr could be translated to the capabilities of Buist when the two are entirely unrelated. Moreover, it is unclear to Applicants how combining Barr and Buist in the manner suggested by the Examiner would make “the process easy and [optimize] the investment portfolio.”

Further, Applicants respectfully assert that the Examiner is incorrect in saying that “Barr discloses speech recognition that is used in stock portfolio selection...in column 2, lines 41-67.” The recited portions of Barr teach the use of *neural networks* (not speech recognition) for selection of time series data in the problem of stock portfolio selection.

The Examiner seems to be confusing “neural networks,” which can be used to *solve problems* in speech recognition, with speech recognition itself. Even from a cursory review of Barr, it is clear that it is unconcerned with speech recognition.

For at least the reasons presented above, claim 1 is believed to be patentably distinguishable over the combination of Buist and Barr. Independent claims 13 and 22 are also believed to be allowable for at least the reasons given for claim 1.

Additionally, regarding claim 13, the Examiner disagrees with the argument that the combination of Barr and Buist does not teach or suggest “automatically updating the database...including adding new entries for newly listed stocks and newly listed funds.” In particular, the Examiner responds by arguing that “Buist’s order book not only show [sic] how a particular stock/fund is trading, it also display [sic] most active stocks (col. 11, lines 62-67) and as shown in fig. 6 and column 12, line 62 through column 13, line 14, it can also display new stocks and related information.” Applicants respectfully disagree that Buist shows “automatically updating the database...including adding new entries for newly listed stocks and newly listed funds,” as claimed in claim 1. The recited portion of Buist simply teaches that a user can click on the “symbol” button 664 to display “a data field...wherein *the user may enter the symbol of the new stock to be displayed.*” At best, the recited portion of Buist simply teaches that a user can enter a stock symbol of one stock to view associated information, and then enter a “new” stock symbol other than the one previously entered. The associated information for the “new” stock symbol entered by the user is already present within Buist and *not* added by the user, much less *automatically* updated. Clearly, the recited portion of Buist is entirely unrelated to “automatically updating the database...including *adding new entries for newly listed stocks and newly*

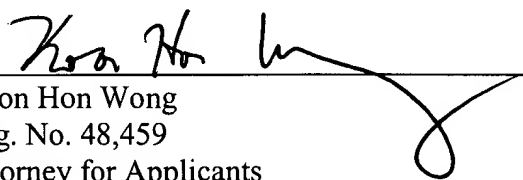
listed funds.” Further, the Examiner has failed to address Applicants’ original argument that the combination of Buist and Barr also fail to teach or suggest “*removing* any of the plurality of entries corresponding to newly unlisted stocks and newly unlisted funds” and “*automatically updating the grammar file* with respect to the newly listed stock names and the newly listed fund names,” each as claimed in claim 1. It is respectfully reminded that the Examiner must address each and every limitation of the claims, and provide adequate citation with respect to those limitations.

Accordingly, independent claims 1, 13 and 22 are believed to be patentably distinguishable over the combination of Buist and Barr. Dependent claims 2-12, 14-21 and 23-33 are believed to be allowable for at least the reasons given for claims 1, 13 and 22. Withdrawal of the rejection of claims 1-33 is respectfully requested.

In view of the foregoing remarks, it is respectfully submitted that all the claims now pending in the application are in condition for allowance. Early and favorable reconsideration is respectfully requested.

Respectfully submitted,

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